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Applicant: Cope
Appl. No.: 10/562,044
International Filing Date: June 28, 2004
Title: METHOD AND APPARATUS FOR THE CREATION, LOCATION AND
FORMATTING OF DIGITAL CONTENT
Attorney Docket No.: 0090227
Pub. No.: US 2007/0162465 A1
Pub. Date: July 12, 2007

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on September 13, 2007, for the above-identified application

The request is dismissed.

Applicant requests that the application be republished because the patent application publication contains material errors, wherein the substituted claims were not published.

37 CFR 1.221 (b) is applicable "only when the Office makes a **material mistake** which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹

The request for corrected publication, received on September 13, 2007, was not timely filed under 37 CFR 1.221(b).

The error noted by requestor with respect to the substitute claims is not an Office error. The patent application publication does not include a mistake regarding the failure to include improperly submitted substitute claims. The substitute claims 1-30 do not comply with Sec.

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

1.121 and 1.125, in that the claims do not have the proper instructions or identifiers. The patent application publication does not include a mistake regarding the failure to include the improper preliminary amendment to the claims in the publication by the Office because patent application publications are not required to include preliminary amendments, according to 37 CFR 1.215(a),² which says the following, in part:

(a) . . . The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application. **The patent application publication may also be based upon amendments** to the specification (other than the abstract or the claims) that are reflected in a substitute specification under Sec. 1.125(b), amendments to the abstract under Sec. 1.121(b), amendments to the claims that are reflected in a complete claim listing under Sec. 1.121(c), and amendments to the drawings under Sec. 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. (emphasis added)

Furthermore, while the patent application publication may now include a preliminary amendment, the Office is not required to use the preliminary amendment.

The applicant is advised that a “request for republication of an application previously published” may be filed under 37 CFR 1.221(a). Such a request for republication “must include a copy of the application compliance with the Office’s electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i).” If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Applicant is reminded of his duty to conduct a reasonable inquiry before filing a paper before the Office. See MPEP 410.

Applicants’ request for a corrected patent application publication on September 13, 2007, may constitute a “failure to engage in reasonable efforts to conclude processing or examination of the application.” See 1.704(c). This determination will be made on or after a mailing of a Notice of Allowance.

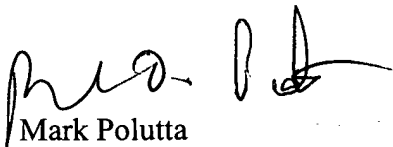
²Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan; Final Rule, 69 FR 56482 (Sept. 21, 2004).

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a "Pre-Grant Publication" and questions or request for reconsideration of the decision, should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450

By facsimile: 571-273-8300

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.

A handwritten signature in black ink, appearing to read 'Mark Polutta', with a stylized flourish at the end.

Mark Polutta
Senior Legal Advisor
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Office of the Deputy Commissioner
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